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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,216	06/22/2001	Veronique Guillou	209310US0	8029

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EXAMINER

WILLIS, MICHAEL A

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 09/10/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/886,216

Applicant(s)

GUILLOU ET AL.

Examiner

Michael A. Willis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Applicant's amendment of 13 June 2002 is entered. Claims 1, 3, 19, and 20 are amended. Claims 21-27 are added. Claims 1-27 are pending. Any previous rejections that are not restated in this Office Action are hereby withdrawn. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Amendment/Arguments

Claims 1-7 and 9-19 are rejected under 35 USC 102(b) as being anticipated by Lance-Gomez et al (US Pat. 6,007,769) for reasons as stated previously.

Applicant asserts that Lance-Gomez neither teaches nor suggests the claimed invention. Applicant argues that since Lance-Gomez teaches compositions having cleansing properties for uses such as oven cleaning, one skilled in the art would not be motivated to place such harsh industrial strength compositions "on delicate human skin for any purpose". Therefore, applicant asserts that Lance-Gomez neither teaches nor suggests that his compositions can be applied to skin.

In response to applicant's argument with respect to the use of the compositions "on delicate human skin", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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In the instant case, the claims are drawn to compositions rather than methods of use. Furthermore, even if the intended use of the compositions "on delicate human skin" were given patentable weight (which it is not), none of the claims rejected under 35 USC 102(b) contain the feature upon which applicant relies. The claims merely contain the preamble phrase "physiologically-acceptable composition". A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). It is further noted that the components of Example 1, for example, are not incompatible with use on human skin.

Claims 1-22, 24, and 26 are rejected under 35 USC 103(a) as being unpatentable over Lance-Gomez et al (US Pat. 6,007,769) in view of Rosser (EP 0 339 994).

Applicant's arguments with respect to the deficiencies of Lance-Gomez individually are addressed above. Applicant asserts that Rosser fails to compensate for the deficiencies of Lance-Gomez. Applicant argues that Lance-Gomez expressly criticizes Rosser with the citation from Lance-Gomez that Rosser "does not teach or suggest robust soap compositions". Applicant argues that therefore, the references lack motivation to combine, in that one of ordinary skill would not combine Lance-Gomez

with a reference that was known to disclose unstable compositions. On the contrary, the critique of Rosser by Lance-Gomez immediately suggests to one of ordinary skill the connection between the two references. One of ordinary skill would understand that Lance-Gomez teaches the remedy to the deficiencies of Rosser, in that the benefits and applications of Rosser can be further improved by incorporation into the robust soap compositions taught by Lance-Gomez.

Applicant further argues that the combination of Lance-Gomez and Rosser would render the prior art unsatisfactory for its intended purpose, since Rosser supposedly teaches away from stable compositions. Rather than teaching away from stable compositions, Rosser merely has deficiencies with respect to stability. The references are suitable for combination, in that Lance-Gomez teaches the remedy for the deficiencies of Rosser. One of ordinary skill in the art is motivated to combine the incremental improvements of Lance-Gomez to the prior art of Rosser in order to benefit from the teachings of Rosser in a robust soap composition. With respect to the new claims, Rosser clearly teaches transparent viscous creams, meeting the definition of "foaming creams" as defined in the specification (see page 2, lines 4-8).

The following new grounds of rejection are made:

Claim Rejections - 35 USC § 102

Claims 21, 23, 25, and 27 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hawkins (EP 0 598 335). Hawkins discloses methods for the use of aqueous based surfactant compositions as cleaning compositions, particularly for use in

cleaning human skin (see page 7, lines 5-10, and lines 27-28). The compositions are described as "VI phase" which means they have a cubic phase (see page 6, lines 27-39; page 13, claim 18). The surfactants are chose such that the VI phase melts at a temperature most preferably above 40°C, and also below 100°C (see page 8, lines 8-11).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-

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1679. The examiner can normally be reached on alt. Mondays and Tuesday to Friday(9am-6:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russell Travers (acting SPE) can be reached on (703) 308-4603. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Michael A. Willis
Examiner
Art Unit 1617

maw
September 6, 2002



RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200